

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, claims 27-35 and 37-38 are pending. Claims 27 and 37 are amended to set forth truncated murine Fuc-TVII enzymes. Support is found, for example, in Figure 1a and in the accompanying legend on page 8, line 7 through page 9, line 25; and on page 59, line 3 through page 61, line 10. No new matter is added by the present amendments, and the Examiner is respectfully requested to enter them.

Request for Rejoinder

Pursuant to M.P.E.P. § 821.04, Applicants respectfully request rejoinder of method claims 27-35. In accordance with M.P.E.P. § 821.04, Applicants have amended claim 27 to correspond to the scope of claim 37.

Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 37 and 38 under 35 U.S.C. § 103(a) as allegedly rendered obvious over U.S. Patent No. 5,585,752 ("Seed") in view of Sasaki, *et al.*, *J Biol Chem* (1994) 269:14730 ("Sasaki"). To the extent that this rejection applies to the amended claims, Applicants respectfully traverse.

The Examiner acknowledges that Applicants have provided evidence of possession prior to the June 7, 1995 filing date of Seed of cDNA encoding murine Fuc-TVII and the expression of murine Fuc-TVII enzyme. *See*, page 3 of the present Office Action. However, the Examiner alleges that the assays showing catalytic activity of the different mouse Fuc-TVII enzymes in cell extracts is insufficient evidence of isolated enzyme.

Applicants do not agree with the Examiner's position. However, in the interest of furthering prosecution, Applicants have amended claim 37 to set forth a truncated murine Fuc-TVII enzyme comprising a catalytic domain that is encoded by a nucleic acid sequence segment that is identical to a polynucleotide that is amplified using murine mRNA or cDNA as a template by a 5' primer as shown in SEQ ID NO:3 and a 3' primer as shown in SEQ ID NO:4.

Applicants teach numerous permutations of truncated murine Fuc-TVII enzymes comprising a catalytic domain. *See, e.g.*, the Specification at Figure 1a. Applicants' Declaration submitted on April 30, 2008 also provides evidence of possession of numerous permutations of truncated murine Fuc-TVII enzymes comprising a catalytic domain prior to the June 7, 1995 filing date of Seed. *See, e.g.*, Exhibits G, H and I and paragraphs 10-16 of the Rule 131 Declaration submitted on April 30, 2008.

Therefore, Applicants maintain their position that Seed is not prior art.

Applicants have provided evidence of conception and reduction to practice of the claimed invention prior to the June 7, 1995 filing date of Seed. Sasaki does not cure the deficiencies of Seed. Accordingly, in view of the foregoing, the Examiner is respectfully requested to withdraw the present rejection.

Appl. No. 10/700,505
Amdt. dated October 15, 2008
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1651

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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